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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/796,593

03/09/2004

Steven R. Hayter

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25397

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08/17/2006

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EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT

PAPER NUMBER

3672

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



<b>Office Action Summary</b>	Application No. 10/796,593	Applicant(s) HAYTER ET AL.	
	Examiner Jennifer H. Gay	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-14 and 18-20 is/are allowed.
- 6) ☒ Claim(s) 1-7 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 26 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |



## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 1-7 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3, and 4 are considered to be indefinite because it is not clear how the locking assembly can be incapable of being moved by a force or pattern of forces applied thereto and releasable at the same time. Correction and clarification are required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:  
A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
4. Claims 1-7 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Patel (US 2002/0066573).

*Regarding claim 1:* Patel discloses lock mechanism for a downhole tool. The lock mechanism includes the following features:

- A stationary component **44a, 44b**.
- A final controlled element **22**.
- A movable component **13** movable with respect to said stationary component and linked to the final controlled element to put said final controlled element in at least two positions.
- A lock assembly **206** triggered by a predetermined movement of said movable component that acts to impede movement of said movable component with respect to said stationary component.



*Regarding claim 2:* The lock assembly is automatically triggered when said final controlled element reaches a predetermined position.

*Regarding claims 3, 4:* The lock assembly is releasable after it is triggered.

*Regarding claim 5:* The lock assembly includes a pair of shoulders that can pass by each other until the predetermined movement is reached whereupon a locking member **215** extends at least one of said shoulders to selectively prevent them from passing each other (see paragraphs [0019], [0020], [0036], and [0037]).

*Regarding claim 6:* The locking member moves relatively to said shoulder that it extends.

*Regarding claim 7:* The locking member comprises at least one collet mounted to the movable member.

*Regarding claim 15:* The lock assembly can be released by relative movement between itself and the shoulder that it had extended as a result of a part of said movable component being released to operate said final controlled element into another of its said two positions.

*Regarding claim 16:* Patel disclose a lock assembly for a downhole valve where the lock assembly includes the following features:

- A stationary housing **44a, 44b**.
- A mandrel **13** movably mounted with respect to said housing and connected to a valve member **22** to selectively open and close said valve member in response to a predetermined movement of said mandrel.
- A lock **206** that automatically engages when said valve member reaches one of said open and closed positions, said lock selectively defeated to allow movement of said valve member to the other of said open and closed positions.

*Regarding claim 17:* The lock selectively retains said mandrel to said stationary housing.

#### ***Allowable Subject Matter***

5. Claims 8-14 and 18-20 are allowed.



### ***Response to Arguments***

6. In view of applicants' amendment, the objections to the drawings and claims have been withdrawn.

7. Applicant's arguments filed June 26<sup>th</sup>, 2006 have been fully considered but they are not persuasive.

Applicant has argued that the locking assembly of Patel does not function the same as that recited in claim 1 because the locking assembly 206 is released by the application of a force by a shifting tool 16 and the locking assembly recited in claim 1 does not let go when a force or pattern of forces is applied thereto.

While the examiner agrees with applicant's assessment of the locking assembly of Patel, it is noted that the locking assembly of the instant application functions in a similar fashion. As indicated in paragraph 0027 of the instant application, the locking assembly is defeated or released when a tool is inserted into the assembly thus shifting the mandrel 10 and causing the collet heads to move and unlocking the valve member. This is very similar to how the locking assembly and valve member of Patel function. Therefore, it is not clear how the locking assembly of Patel differs from that of the instant application.

The examiner recognizes that claim 1, and claim 16, has been amended to indicate that the locking assembly does not release the final controlled element regardless of the force applied to the locking assembly. However, it is the opinion of the examiner that this language is contrary to the actual functionality of the locking assembly of the instant application. This is evidenced by paragraph 0027 and claims 3 and 4 that require that the locking assembly be releasable after it is triggered.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).



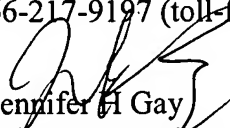
Art Unit: 3672


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H. Gay whose telephone number is (571) 272-7029. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer H. Gay  
Primary Examiner  
Art Unit 3672

JHG   
August 8, 2006